

REMARKS:

Claims 1-38 are currently pending in the present Application. Claims 6-8, 11, and 26-38 stand withdrawn from consideration. Claims 6-8, 11, and 26-38 are hereby cancelled.

Claims 1-25 stand provisionally rejected on the grounds of nonstatutory obviousness-type double patenting, as being unpatentable over claims 1, 2, and 4-6 of co-pending Application 11/072,382 (the "'382 application").

Claims 1-25 stand provisionally rejected on the grounds of nonstatutory obviousness-type double patenting, as being unpatentable over claims 1, 2, and 4-25 of co-pending Application 10/523,942 (the "'942 application").

Claims 1, 9, 10, 12, 13, 15, 20, and 21 stand rejected under 35 USC § 102(b) as being anticipated by U.S. Patent No. 6,117,526 to Marks ("Marks").

Claims 2-5, 14, 16-19, and 22-25 stand rejected under 35 USC § 103(a), as being unpatentable over Marks in view of WO 00/08622 to Neal ("Neal").

Provisional Double Patenting Rejections:

Claims 1-25 stand provisionally rejected on the grounds of nonstatutory obviousness-type double patenting, as being unpatentable over claims 1, 2, and 4-6 of the '382 application. In addition, Claims 1-25 stand provisionally rejected on the grounds of nonstatutory obviousness-type double patenting, as being unpatentable over claims 1, 2, and 4-25 of the '942 application.

Applicant notes these provisional rejections, which will be taken up in due course upon allowance of either the '382 application or the '942 application.

Rejections Under 35 U.S.C. § 102(b):

Claims 1, 9, 10, 12, 13, 15, 20, and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Marks. The Applicant respectfully traverses the rejection for at least the reasons set forth below.

As set forth in Applicant's Response to Office Action of 25 July 2008, which was filed on 29 December 2008, the Examiner must identify wherein each and every facet of the claimed invention is disclosed in an applied reference. As the Examiner knows, "it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference."¹ Again, the Applicant submits that the Examiner has failed to meet this burden. The Examiner merely states that:

Marks discloses a slip resistant appliqué skin for use with a hand held electronic device comprising a decorative substrate layer 120, an anti-slip layer 110 there over [sic] and an adhesive layer 130 on the substrate which would be disposed between the device and substrate per claim 1. Refer to the Abstract, figure 1 and column 4, line 54 through column 5, line 59. With regards to claims 9, 10, 12 and 13, the textured surface of layer 110 is non-smooth and contains a combination of depressed and/or raised portions as shown in figure 1. With regards to claim 15, see column 2, lines 63-65. With regards to claims 20 and 21, two separate portions are shown in figure 3.

The Examiner has again failed to address many "facets of the claimed invention," for example:

Claim 1: "the anti-slip layer having a surface finish having a high coefficient of friction so as to restrict movement of the handheld electronic device relative to a contact surface ..." and "the skin is selectively shaped to conform to the contours, shape, and components of the handheld electronic device."

¹ *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990).

Claim 15: "the anti-slip layer is formed of a compressible material such that the anti-slip layer provides shock absorption."

Claim 20: "the anti-slip layer having a surface finish having a high coefficient of friction so as to restrict movement of the handheld electronic device relative to a contact surface ..." and "the first portion and each additional portion are selectively shaped to conform to the contours, shape, and components of the handheld electronic device."

Claim 21: "the first portion and the second portion are adapted to be separated from each other prior to attachment to the handheld electronic device."

The Examiner has again failed to indicate which elements of the applied reference correspond to the claimed features. The Examiner has only considered some of the features of the claims, and has failed to consider **all** of the features of the claims. This partial examination of the claims is improper. For "[i]t is by now well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office."² As such, the Applicant respectfully submits that the Examiner's rejection of Claims 1, 9, 10, 12, 13, 15, 20, and 21, as being anticipated by Marks is *prima facie* deficient, and for at least this reason, is improper and should, therefore, be withdrawn.

Notwithstanding the foregoing, the Applicant submits that Marks does not anticipate the claimed skin. The Marks device has nothing to do with providing a thin, soft, anti-slip appliqué having, in and of itself, a high coefficient of friction. The object of the Marks device is to allow a user to better grasp a laptop computer. Marks is merely placing strips of 3M's Safety-Walk™ General Purpose Antislip tape or 3M's Safety-

² *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) quoting *In re Warner*, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967); *Ex parte Skinner*, 2 U.S.P.Q.2d (BNA) 1788, 1788-89 (Bd. Pat. App. & Int. 1987).

Walk™ Conformable Antislip tape on laptop computers. Marks' "General Purpose" product "consists of abrasive mineral particles bonded by a tough, durable polymer to a dimensionally stable plastic film."³ In addition, Marks' "Conformable" product "consists of abrasive particles bonded by a tough, durable polymer to an aluminum foil backing."⁴ Marks teaches using other anti-slip tapes in 3M's Safety-Walk™ line of products. The Marks tape works on the principle of toothed bonding between a gritty tape and a soft surface. The Marks tape does not work to keep the abrasive tape from slipping on a hard smooth surface, such as a glass table top.

The Marks material does not have a high coefficient of friction in and of itself. With the Marks tape, friction is generated when a soft contact surface, such as human flesh or the sole of a shoe, is pressed into the hard upraised bumps and ridges formed by the hard abrasive particles. Marks teaches generating friction by the mechanical compression engagement between hard particles on a strip and soft human flesh, not the inherent surface characteristics of the material. The Marks product is only slip resistant because of its texture, height, and gaps between strips. Because the Marks tape consists of hard, abrasive particles, it is not a thin, soft skin. The Marks material would be more susceptible to scratching a contact surface. This type of roughly textured surface is precisely what the claimed skin seeks to avoid. This is illustrated in Figure 3 of Marks and discussed at column 6, lines 17-18: "The openings between the strips provide a multi-edge tread like surface to bind with the hand." This is not possible with a thin, soft material, such as the claimed skin.

The claimed skin does not utilize hard abrasive particles to produce friction; nor does the claimed skin utilize a side-by-side arrangement of strips to "bind" with a user's hand. The high coefficient of friction in the claimed skin is inherent in the surface finish of the anti-slip layer. Furthermore, the claimed skin is a soft, thin appliqué, i.e., less than about 0.5 millimeters. As such, the claimed skin does not rely upon mechanical compressive force to generate friction, nor does the claimed skin "bind" with a user's

³ Marks, col. 5, ll. 18-20.

⁴ Marks, col. 5, ll. 26-27.

flesh. The Marks tape could not "bind" to a user's flesh if it were soft and thin like the claimed skin. The surface finish of the anti-slip layer in the claimed skin produces the high coefficient of friction, which in turn prevents slipping when the hand held device is placed on a contact surface. These features and limitations are present in each of Claims 1, 9, 10, 12, 13, 15, 20, and 21.

Claims 1 and 20 are hereby amended by adding the term "non-abrasive" to clarify that the high coefficient of friction is not generated by abrasive particles.

For at least these reasons, the Applicant submits that Marks fails to anticipate the claimed skin. Therefore, the Applicant respectfully requests that Claims 1, 9, 10, 12, 13, 15, 20, and 21, as amended, be allowed.

Rejections Under 35 U.S.C. § 103(a):

Claims 2-5, 14, 16-19, and 22-25 stand rejected under 35 USC § 103(a), as being unpatentable over Marks in view of Neal. The Applicant respectfully traverses the rejection for at least the reasons set forth below.

As set forth in Applicant's Response to Office Action of 25 July 2008, which was filed on 29 December 2008, the Examiner must identify wherein each and every facet of the claimed invention is disclosed in an applied reference. As the Examiner knows, "it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference."⁵ Again, the Applicant submits that the Examiner has failed to meet this burden.

The Examiner has again failed to address many "facets of the claimed invention," for example:

Claim 1: "the anti-slip layer having a surface finish having a high coefficient of friction so as to restrict movement of the handheld electronic

⁵ *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990).

device relative to a contact surface ..." and "the skin is selectively shaped to conform to the contours, shape, and components of the handheld electronic device."

Claim 16: "the anti-slip layer is polarized such that an image on the decorative layer changes when viewed from different angles."

Claim 17: "the anti-slip layer is formed from liquid silicone resin"

Claim 20: "the anti-slip layer having a surface finish having a high coefficient of friction so as to restrict movement of the handheld electronic device relative to a contact surface ..." and "the first portion and each additional portion are selectively shaped to conform to the contours, shape, and components of the handheld electronic device."

Claim 21: "the first portion and the second portion are adapted to be separated from each other prior to attachment to the handheld electronic device."

Claim 23: "either the first portion or one of the additional portions is formed from liquid silicone resin."

The Examiner has again failed to indicate which elements of the applied reference correspond to the claimed features. The Examiner has only considered some of the features of the claims, and has failed to consider **all** of the features of the claims. This partial examination of the claims is improper. For "[i]t is by now well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office.⁶ As such, the Applicant respectfully submits that the Examiner's rejection of Claims 2-5, 14, 16-19, and 22-25, as being unpatentable over Marks in view

⁶ *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) quoting *In re Warner*, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967); *Ex parte Skinner*, 2 U.S.P.Q.2d (BNA) 1788, 1788-89 (Bd. Pat. App. & Int. 1987).

of Neal is *prima facie* deficient, and for at least this reason, is improper and should, therefore, be withdrawn.

Notwithstanding the foregoing, the Applicant submits that Marks in view of Neal does not render the claimed skin obvious. The Examiner states that the primary reference, i.e., Marks, teaches the invention substantially as recited but is silent as to the thicknesses of the layers and the presence of a decorative layer. The Examiner states that Neal discloses that an anti-slip label can be formed with the anti-slip layer 4 and decorative layer (any of 4-7) can be of a thickness of less than 0.5mm per claims 2 and 22, citing figures 1-3, page 8, lines 7-9, and page 10, lines 6-10. With that, the Examiner states that it would have been obvious to one having ordinary skill in the art at the time the invention was made to Marks [sic] to form the anti-slip layer and decorative layer of a thickness of less than 0.5mm, as is taught to be known by Neal, since those are known thicknesses for those layers.

The Applicant reiterates here all of the distinguishing comments set forth above with respect to the Marks reference. In particular, the Applicant submits that the Marks device has nothing to do with providing a thin, soft, anti-slip appliqué having a high coefficient of friction. The object of the Marks device is to allow a user to better grasp a laptop computer. The Marks tape works on the principle of toothed bonding between a gritty tape and a soft surface. With the Marks tape, friction is generated when a soft contact surface, such as human flesh or the sole of a shoe, is pressed into the hard upraised bumps and ridges formed by the hard abrasive particles. Marks teaches generating friction by the mechanical compression engagement between hard particles on a strip and soft human flesh, not the inherent surface characteristics of the material. The Marks product is only slip resistant because of its texture, height, and gaps between strips. Because the Marks tape consists of hard, abrasive particles, it is not a thin, soft skin. Because Marks requires hard abrasive particles, it teaches away from the claimed skin.

Furthermore, Neal has nothing to do with anti-slip appliqués. Neal deals with soft-touch labels formed as a coextruded sheet of a thermoplastic elastomer and a

polyolefin. Neal is merely a label overlaid with plastic. The plastic itself generates a soft feel. Neal makes no mention whatsoever of providing an anti-slip layer having a surface finish having a high coefficient of friction.

With respect to Claim 3, the Examiner states that all layers above print layer 6 can be transparent in order to be able to view the print layer in Neal, citing page 9, lines 18-20. Although Neal may disclose having transparent layers, Neal does not teach, mention, or disclose providing an anti-slip layer having a surface finish having a high coefficient of friction to restrict movement of a hand held electronic device relative to a contact surface.

With respect to Claim 4, the Examiner states that a print layer 6, or printing on layers 3, is disclosed at layer 6 and page 9, lines 1-14. Although Neal may disclose printing on one of the layers, Neal does not teach, mention, or disclose providing an anti-slip layer having a surface finish having a high coefficient of friction to restrict movement of a hand held electronic device relative to a contact surface.

With respect to Claim 5, the Examiner states that the outer surface of elastomeric anti-slip layer 4 "appears" smooth, citing figures 1-3. The Examiner is improperly reading into Neal features that are not disclosed in Neal. Neal makes no mention of the surface finish of layer 4. Neal does not teach, mention, or disclose providing an anti-slip layer having a surface finish having a high coefficient of friction to restrict movement of a hand held electronic device relative to a contact surface.

With respect to Claim 14, the Examiner states that the product is a label stock, citing the Abstract and page 8, lines 26-28. Although Neal may disclose a base label, Neal does not teach, mention, or disclose providing an anti-slip layer having a surface finish having a high coefficient of friction to restrict movement of a hand held electronic device relative to a contact surface.

With respect to Claims 18, 19, 24, and 25, the Examiner merely states "see page 3, line 21 through page 7, line 36 for the thermoplastic rubber used for the anti-slip layer." Although Neal may discuss thermoplastic rubber, Neal does not teach, mention,

or disclose providing an anti-slip layer having a surface finish having a high coefficient of friction to restrict movement of a hand held electronic device relative to a contact surface.

With respect to Claims 17 and 23, the Examiner summarily states that "to substitute silicone resin for the elastomer as taught by Neal would be obvious to one of ordinary skill in the art since this would merely involve substituting one anti-slip material for another one." Neither Marks nor Neal teach, mention, suggest, or otherwise disclose the use of a liquid silicone rubber to form the anti-slip layer having a high coefficient of friction. The unique combination of materials gives the claimed skin its unique characteristics, including its high coefficient of friction, and its ability to prevent hand held devices from slipping. The references cited by the Examiner simply do not disclose these features.

Thus, the Examiner has provided no teaching, suggestion, or motivation in the prior art that would have lead one of ordinary skill in the art to modify either Marks or Neal to arrive at the claimed invention. Rather, the Applicant respectfully submits that any attempt to assert that either Marks or Neal discloses or suggests the claimed invention as a whole is necessarily based on an improper use of hindsight using Applicant's disclosure as a roadmap.

For at least these reasons, the Applicant submits that the claimed skin is not unpatentable over Marks in view of Neal. Therefore, the Applicant respectfully requests that Claims 2-5, 14, 16-19, and 22-25, as amended, be allowed.

Distinctions, Other Than Those Discussed, May Exist:

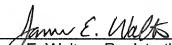
It should be noted that Applicant has merely discussed example distinctions from the various references cited by the Examiner. Other distinctions may exist and Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal. By not responding to the additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The remarks provided above are sufficient to overcome the Examiner's rejections.

CONCLUSION:

In view of the foregoing amendments and remarks, the Applicant submits that the subject application is now considered to be in condition for allowance, and an early reconsideration and issuance of a Notice of Allowance are earnestly solicited. The Examiner is invited to contact the undersigned at (817) 447-9955 with any questions, comments, or suggestions relating to the referenced patent application.

Respectfully submitted,

12/7/09
Date



James E. Walton, Registration No. 47,245
Law Offices of James E. Walton, P.L.L.C.
1169 N. Burleson Blvd., Suite 107-328
Burleson, Texas 76028
(817) 447-9955 (Voice)
(817) 447-9954 (Facsimile)
jim@waltonpllc.com (Email)

CUSTOMER NO. 38441

ATTORNEY FOR APPLICANT